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EXAMINER

IP, SIKYIN

ART UNIT

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 5-7, 19-21, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Housh et al (ASM Metals Handbook, vol. 2, 10th ed, AZ80A alloy).

Housh discloses the features including Mg based tube, composition, tensile properties, and elongations (pages 1-2). Therefore, when prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known,

one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). As stated in In re Peterson, 315 F.3d 1325, 1329-30, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003), that “A prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art”.

Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123.

With respect to the limitations in instant claims 19-21 that read smooth surface, no residual tensile stress, uniform diameter, respectively which are contemplated within ambit of ordinary skill artisan. With respect to claims 25-26 that are design choice in view of application of the pipe.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Housh et al (ASM Metals Handbook, vol. 2, 10th ed, AZ80A alloy) as applied to claims above, and further in view of Becker et al.

Housh discloses the features substantially as claimed as set forth in the rejection above except for cross-section shape of a pipe. However, Becker discloses pipes can be in different shapes (Figure 2, right) in the same field of endeavor or the analogous

metallurgical art. Making pipes in shapes known in the art of cited references is contemplated within ambit of ordinary skill artisan.

Response to Arguments

Applicant's arguments filed 1/8/08 and 1/28/08 have been fully considered but they are not persuasive.

~~such as, a bar, rod, and their shapes.~~ Housh is *silent* regarding a Mg based alloy pipe produced

Applicants argue that “ by **drawing** a pipe blank of Mg base alloy, ”

But, applicants' attention is directed to Housh below that tubing has been taught

Government. Extruded bar, rod, and shapes: QQ-M-31B. Extruded tubing: WW-T-825. Forgings: QQ-M-40B

~~e.g., pg. 1, lines 24-47; pg. 17, lines 1-5; and Table 1).~~ The inventive examples of drawn pipes

Applicants argue that “ of AZ31 have a tensile strength ranging from 303-395 MPa. ~~Thereby, as taught in the instant~~ ”

Applicants' attention is directed to Table 7 of Housh that the AZ80A alloys have tensile strength from 330-380 MPa.

Applicants' argument with respect to Becker is noted. But, Becker is cited to show the claimed shapes of pipes are conventional. The claimed drawn pipe tensile strength has overlapped by the tubing/pipe of Housh and/or Becker.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121; 37 C.F.R. Part §41.37 (c)(1)(v); MPEP §714.02; and MPEP §2411.01(B).

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Thursday from 5:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1793

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sikyin Ip/
Primary Examiner, Art Unit 1793

April 27, 2008